

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Robert Gentile

Application No.: 09/825,997

Confirmation No.: 3856

Filed: April 5, 2001

Art Unit: 2184

For: NETWORK BASED BIOS RECOVERY
METHOD

Examiner: G. L. Chu

PRE-APPEAL BRIEF REQUEST FOR REVIEW

MS AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

The Office action mailed February 9, 2007, rejected claims 1-52. The applicant respectfully requests a pre-appeal brief review of these rejections in light of the remarks presented in this request.

I. Claim 1 is not anticipated by the cited prior art

Claim 1 stands rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 6,314,455 ("Cromer"). This rejection is respectfully traversed because Cromer does not teach every limitation of claim 1.

Claim 1 recites, "[a] method of recovering from a corrupt computer system BIOS" that comprises, inter alia, "programming said uncorrupted BIOS onto said computer system's BIOS storage area" and "rebooting said computer system **once** after determining that said BIOS is corrupt, said rebooting occurring after said programming" (emphasis added). The present application discloses this feature in figure 1 and its textual description. These portions of the application describe a method of recovering from a corrupted BIOS where a computer reboots only a single time after detecting a corrupted BIOS (see step 12, then step 20, then step 13). The

above-quoted text of claim 1 was added in the Amendment filed August 14, 2006 to clarify that, in contrast to Cromer, the method of claim 1 includes only one rebooting of the computer after the detection and reprogramming of a corrupted BIOS.

Cromer does not teach or suggest this limitation. Although Cromer teaches a method of recovering from a failure caused by corrupt boot code, as explained in figure 4 and its description, this method requires a client computer to reboot several times after detecting an error condition. Specifically, the method includes rebooting the computer system first at step 420 after the detection of a corrupt BIOS than rebooting the computer system again at step 428 after receiving a flash image from a server. It is important to note that, in Cromer, a "reset" operation includes rebooting the computer system. See lines 61-62 of column 1 ("[w]hen a computer is reset or initially powered-on, a boot process begins"). Thus, the method of Cromer includes at least two rebooting operations at steps 420 and 428.

The most recent Office action highlights the "Boot operating system" function of step 410. Even if this step is interpreted as corresponding to the "rebooting said computer system" of claim 1, then figure 4 discloses three rebooting operations instead of two at steps 420, 428, and 410. However, such an interpretation is not reasonable because step 410 describes an initial booting instead of a "rebooting" (emphasis added) and because booting an "operating system" does not correspond to booting an entire "computer system" as the operating system is only one component of a computer system.

Thus, Cromer not only doesn't teach or suggest the above-quoted limitation of claim 1, but Cromer teaches away from the limitation by requiring a computer to reboot more than once. Moreover, altering Cromer to include the above cited-limitation would change the principle of operation of Cromer.

As Cromer does not teach or suggest every limitation of claim 1, Cromer does not anticipate this claim. Regarding the other references cited in the action, nothing has been cited or found in these references that pertains to the above-quoted limitation of claim 1.

II. Claim 1 is patentable under § 112

Claim 1 stands rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Specifically, the action asserts that the specification does not support "[a] method of recovering from a corrupt computer system BIOS" comprising the

step of "rebooting said computer system once after determining that said BIOS is corrupt, said rebooting occurring after said programming." This rejection is respectfully traversed.

"To satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention." M.P.E.P. § 2163(I) (citing *Moba, B.V. v. Diamond Automation, Inc.*, 325 F.3d 1306, 1319, 66 U.S.P.Q.2d 1429, 1438 (Fed. Cir. 2003) and *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563, 19 U.S.P.Q.2d 1111, 1116 (Fed. Cir. 1991)). Furthermore, when a method in an application inherently performs a certain function, the applicant can later amend the claims to recite that inherent function even though the application does not explicitly describe the inherent function. M.P.E.P. § 2163.07(a) (citing *In re Reynolds*, 443 F.2d 384, 170 U.S.P.Q. 94 (C.C.P.A. 1971), *In re Smythe*, 480 F.2d 1376, 178 U.S.P.Q. 279 (C.C.P.A. 1973), and *In re Robertson*, 169 F.3d 743, 745, 49 U.S.P.Q.2d 1949, 1950-51 (Fed. Cir. 1999)).

This rejection is improper, first, because one skilled in the art could have reasonably concluded that the inventor had possession of the invention of claim 1. The flowchart shown in figure 1 clearly shows a method of recovering from a corrupt computer system BIOS that includes rebooting only "once." This occurs at step 20, and no other steps are described that include rebooting. Thus, from simply studying the method of figure 1, one of ordinary skill would have concluded that the inventor had possession of the invention described by claim 1.

Moreover, the above-quoted feature of claim 1 is inherent to the method shown in figure 1. For example, rebooting the computer system a second time (not "once") after determining that the BIOS is corrupt and before the programming would trap the computer system in an endless loop. As such, "rebooting said computer system once after determining that said BIOS is corrupt, said rebooting occurring after said programming" is expressly and inherently disclosed in figure 1. As a result, claim 1 satisfies the written description requirement.

III. Claims 2-52

A. Claims 2-52 are patentable over the cited prior art

Claims 2-14 and 24-48 stand rejected under 35 U.S.C. § 102(e) as anticipated by Cromer. Additionally, claims 15-23 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Cromer in view of Japan Published Application No. 409258965A ("Aoki"); claims 49 and 50 stand

rejected under 35 U.S.C. § 103(a) as unpatentable over Cromer in view of U.S. Patent No. 5,319,519 ("Sheppard"); and claims 51 and 52 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Cromer in view of Aoki and further in view of Sheppard. These rejections are respectfully traversed.

Claims 10, 15, 24, 32, 40, and 48 are patentable over the cited prior art at least because each one of these claims includes a limitation comparable to the above-quoted limitation of claim 1. Claims 2-9, 11-14, 16-23, 25-31, 33-39, 41-47, and 49-52 are patentable at least because they each depend from an allowable base claim.

B. Claims 2-52 are patentable under § 112

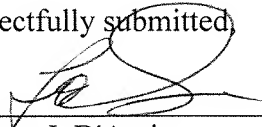
Claims 2-52 also stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. These rejections are respectfully traversed for the reasons presented above in connection with claim 1.

IV. Conclusion

In view of the remarks presented in this request, the applicant believes the pending application is in condition for allowance. If there are any formal matters remaining after this request, the applicant respectfully requests the examiner to telephone the undersigned. If there are any additional fees associated with the filing of this request, including fees required under 35 C.F.R. §§ 1.16 or 1.17, please charge them to deposit account no. 04-1073.

Dated: 5/9/07

Respectfully submitted,

By 
Thomas J. D'Amico
Registration No.: 28,371
E. F. C. Gain Jr.
Registration No.: 55,917
DICKSTEIN SHAPIRO LLP
1825 Eye Street, NW
Washington, DC 20006-5403
(202) 420-2200
Attorneys for Applicant